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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,898	06/13/2001	Tamotsu Kataoka	06854.0017	2847

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EXAMINER

SIMONE, CATHERINE A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 03/07/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/857,898

Applicant(s)

KATAOKA ET AL.

Examiner

Catherine Simone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (EP 0 699 521) in view Watanabe et al. (5,478,617).

Regarding **claim 1**, Watanabe (EP 0 699 521) discloses a multilayered film comprising five layers, characterized in that: a first layer (see page 3, lines 52-54) and a fifth layer (see page 4, lines 36-38) are made of (A) an ethylene α -olefin copolymer having a density of 0.930 to 0.950 g/cm³; a second layer is made of: (B) a mixed resin comprising 30 to 60% by weight of an ethylene α -olefin copolymer having a density of 0.910 to 0.930 g/cm³, 35 to 65% by weight of an ethylene α -olefin elastomer having a density of 0.860 to 0.900 g/cm³ and 1 to 10% by weight of a high-density polyethylene having a density of 0.955 to 0.970 g/cm³ (see page 4, lines 1-10); a third layer is made of: the ethylene α -olefin copolymer (A) (see page 4, lines 19-22); and a fourth layer made of : (C) a mixed resin comprising 35 to 55% by weight of a ethylene α -olefin having a density of 0.900 to 0.930 g/cm³, 40 to 60% by weight of an ethylene α -olefin elastomer having a density of 0.860 to 0.900 g/cm³ and 2 to 8% by weight of a high-density polyethylene

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having a density of 0.955 to 0.970 g/cm³. (see page 4, lines 29-32). However, Watanabe (EP 0 699 521) fails to disclose the ethylene α -olefin in the mixed resin of the fourth layer as being a polypropylene. Watanabe et al. (5,478,617) teaches an ethylene α -olefin being a polypropylene (see col. 5, lines 1-5) in the analogous art for the purpose of producing a layer in a multi-layer film having excellent strength, flexibility and transparency, and a container molded using the film.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the ethylene α -olefin in the mixed resin of the fourth layer in Watanabe (EP 0 699 521) as suggested by Watanabe et al. (5,478,617) in order to produce a layer in a multi-layer film having excellent strength, flexibility and transparency, and a container molded using the film.

Regarding **claim 2**, Watanabe (EP 0 699 521) further fails to disclose the ethylene α -olefin as a polypropylene in the mixed resin of the second layer. Watanabe et al. (5,478,617) teaches an ethylene α -olefin being a polypropylene (see col. 5, lines 1-5) in the analogous art for the purpose of producing a layer in a multi-layer film having excellent strength, flexibility and transparency, and a container molded using the film.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the ethylene α -olefin in the mixed resin of the second layer in Watanabe (EP 0 699 521) as suggested by Watanabe et al. (5,478,617) in order to produce a layer in a multi-layer film having excellent strength, flexibility and transparency, and a container molded using the film.

Regarding **claims 4 and 5**, note the first layer has a thickness in a range of 5 to 15% of the entire film (see page 3, line 55), the second layer has a thickness in a range of 25 to 45% of the entire film (see page 4, line 15), the third layer has a thickness in a range of 2 to 15% of the entire film (see page 4, line 27), the fourth layer has a thickness in a range of 25 to 45% of the entire film (see page 4, lines 31-33) and the fifth layer has a thickness in a range of 7 to 20% of the entire film (see page 4, line 40). Regarding **claim 6**, note the thickness of the whole film is from 200 to 300 μm (see page 4, lines 49-51). Regarding **claim 7**, note a container having the first layer of the multi-layered film as an outer layer and the fifth layer as an inner layer (see page 3, lines 2-15). Regarding **claim 8**, note a container is formed by interposing a port member made of polyethylene between the films and fusing them (see page 4, lines 52-57).

Response to Arguments

3. Applicant's arguments filed December 31, 2002 have been fully considered but they are not persuasive. Applicant states that "On the other hand, in the present invention, the mixed resin containing polypropylene used in the fourth layer and optionally also in the second and third layers is used to provide flexibility, heat resistance, formability and pinhole resistance to the multilayered film (see page 11, line 25 to page 12, line 4 of the specification). See also the purpose for mixed resin (D), which also contains polypropylene in the layers of the multilayered film of the present invention are entirely different from the purpose and effect of the polypropylene in the inner layer of the multilayered film of US '617." However, the purpose and effect of the polypropylene in the layers of the multilayered film of the present invention is not recited in the claims. Furthermore, US '617 was merely cited for suggesting that it is old and

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well-known in the art to have polypropylene being mixed with ethylene α -olefin and high-density polyethylene to form a layer in a multilayered film and that it would be obvious to one of ordinary skill in the art at the time the invention was made to have modified the fourth layer in EP '521 to contain the mixed resin containing polypropylene as suggested by US '671 to produce a multilayered film. One skilled in the art would clearly be able to add polypropylene into the mixed resin of the fourth layer in EP '521, if so desired.

Furthermore, Applicant states "From the above, it is clear that US '617 does not suggest using a mixed resin containing polypropylene for the reason it is used in the present invention. Thus, it cannot be said that one of ordinary skill in the art would expect the results of the present invention from the teachings of EP '521 and US '617, and consequently, the combination of these references as proposed by the Examiner comes only from applicants' specification and not from anything taught by these references." In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (703) 605-4297. The examiner can normally be reached on 9:30-6:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Catherine Simone
Examiner
Art Unit 1772

February 26, 2003



HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772 3/5/03